REMARKS/ARGUMENTS

This amendment is respectfully submitted in response to the non-final Office Action dated December 16, 2004.

I. Introduction

Claims 1-17, 24-25 and 29-35 are pending. Claims 1, 6, 8, 14, 17, 24, 25 and 29 are independent claims. Claims 1-3, 8, 14, 17, 24 and 29 have been amended to clarify these claims. Claims 6 and 25 stand allowed. Applicants thank the Examiner for these allowances.

Claims 2-3 stand rejected under 35 U.S.C. 112, as being indefinite. These claims have been amended in accordance with the Examiner's suggestions. **It is respectfully submitted that the amendments to claims 2 and 3 overcome the Examiner's 35 U.S.C. 112 rejection.**

Claim 8 was rejected under 35 U.S.C. 112 as being incomplete. Claim 8 has been amended to address the Examiner's concerns. **It is respectfully submitted that the amendment to claim 8 overcomes the 35 U.S.C. 112 rejection.**

Claims 1-3, 7, and 24 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,222,909 to Qua, et al. (hereinafter "the Qua et al. patent"). In addition, claims 4, and 9-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the Qua et al. patent in view of U.S. Patent No. 6,385,306 to Baxter, Jr. (hereinafter "the Baxter patent"). Claims 1 and 24 have been amended to address the Examiner's concerns. **It is respectfully submitted that the amendments to independent claims 1 and 24 overcome the 35 U.S.C. 102(e) rejections, and therefore claims 1-3, 7, and 24 are in condition for allowance.**

Claim 4 and claims 9-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the Qua et al. patent in view of the Baxter patent. **It is respectfully submitted that the amendment to independent claim 1 overcomes the 35 U.S.C. 103(a) rejections, and therefore claims 4 and 9-13 are in condition for allowance.**

Claims 5, and 14-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the Qua et al. patent in view of European Application No. EP 0,893,902 A2 to Yaker (hereinafter "the Yaker application"). Independent claims 14 and 17 have been amended to address the Examiner's concerns. **It is respectfully submitted that the amendments to independent claims 1, 14, and 17 overcome the 35 U.S.C. 103(a) rejections, and therefore claims 5 and 14-17 are in condition for allowance.**

Claims 29-35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the Qua et al. patent in view of U.S. Patent No. 5,751,792 to Chau et al. (hereinafter "the Chau et al. patent"). Independent claim 29 has been amended to address the Examiner's concerns. **It is respectfully submitted that the amendment to independent claim 29 overcomes the 35 U.S.C. 103(a) rejection, and therefore claims 29-35 are in condition for allowance.**

In view of the above amendments and following remarks, it is respectfully submitted that all of the pending claims are patentable over the applied references.

II. Summary of the Invention and Discussion of the Applied References

1. Summary and Discussion of the Invention

The present invention is directed to methods and apparatus for retrieving voice mail messages, generating digital files of the messages, and sending the messages as IP packets to a service subscriber. Further, upon receiving a reply email

message, the voice mail messages are deleted, either at the voice messaging system or a stored copy of the message, or both. In another aspect of the invention, voice mail prompts are loaded in the voice messaging system, as directed by the subscriber.

In greater detail, one embodiment of the present invention utilizes a communications device which accesses a subscriber's voice message system. The device retrieves a voice message from the system, over a public telephone network. The device then generates a digital audio file representing the retrieved message, and sends the file as an attachment to an E-mail sent by the device to the subscriber.

In another embodiment, the inventive device receives an E-mail message indicating that the voice message was reviewed by the subscriber, and then controls the voice message system to cause it to delete the retrieved message.

2. The Qua et al. Patent

In contrast to the present invention, the Qua et al. patent describes an audio note taking service which permits a user to record audio information during a conversation on a communications device, and distribute the information to other users, utilizing voice mail and E-mail systems. The notes recorded by one party are independent from the notes recorded by the other parties.

Applicant's communications device **retrieves** voice messages **from** a voice message system, whereas Qua et al. utilizes its system to **upload** recordings **to** a voice message system (col. 3 lns 64-66 "the user can also convert and/or forward the audio note to other users via the user's e-mail or voice mail addresses").

There is no teaching or suggestion in Qua et al. to retrieve voice messages from a voice message system, digitize those messages, and send them via an attachment to an e-mail to the subscriber. There is also no teaching or suggestion in Qua et al. to access the voice message system after a message has been reviewed by the subscriber, and cause the voice message system to delete the retrieved message.

If the Qua et al. note recording system is viewed as being equivalent to Applicant's voice message system, and the user interface of Qua et al. (which controls the recording options) is viewed as being equivalent to Applicant's

communications device, Applicant's invention is still not taught or suggested. In contrast to Applicant's device, the user interface of Qua et al. does not download the audio from a voice message system and then digitize that voice message. In the Qua et al. patent, the note recording system has the capability of digitizing an audio file, and forwarding that digitized file via e-mail. But, quite differently in Applicant's invention, the communications device retrieves the audio recording over a telecommunications network, and then digitizes the retrieved recording.

This distinction is critical to each system, as the Qua et al. patent describes an integrated, coordinated system comprising a note recording system and a user interface that are designed to work and communicate together, whereas Applicant's invention is intended to allow the communications device to simply access a standard voice message system(s), that is not integrated or coordinated with it. The only function of the voice message system in Applicant's invention is to perform its normal voice messaging operations, allowing the communications device to perform all other necessary (inventive) functions (such as digitization and e-mail forwarding). Therefore, there is no reason for, and no teaching in the Qua et al. patent which would suggest, moving the digitizing functionality from the recording device (the note recording system) to the user interface, as specified in Applicant's pending claims.

Finally, there is no teaching or suggestion in the Qua et al. patent to receive an e-mail indicating that a forwarded voice message has been reviewed by a subscriber, and in response causing the voice message system to delete the message.

3. The Secondary References

The Yaker application describes a voice message system that allows the user to select retention periods. Even in combination with Qua et al., there is no teaching or suggestion of retrieving a voice message from a voice message system and digitizing the message. Nor is there any teaching or suggestion of receiving an e-mail indicating that a forwarded voice message has been reviewed by a subscriber, and in

response causing the voice message system to delete the message. Therefore, the Yaker application does not correct the deficiencies in the Qua et al. reference.

The Chau et al. patent describes an adjunct message system that transfers messages from a subscriber's home voice mailbox to a network-based mailbox. Even in combination with Qua et al. and the Yaker application, there is no teaching or suggestion of retrieving a voice message from a voice message system and digitizing the message. Nor do the references suggest receiving an e-mail indicating that a forwarded voice message has been reviewed by a subscriber, and in response causing the voice message system to delete the message. Therefore, the Chau et al. patent also does not correct the deficiencies in the Qua et al. reference.

The Baxter patent describes digitizing an audio file and transmitting it via e-mail to a user-selected e-mail address. Even in combination with Qua et al., the Yaker application, and the Chau et al. patent, there is no teaching or suggestion of retrieving a voice message from a voice message system and digitizing the message. Nor do the references suggest receiving an e-mail indicating that a forwarded voice message has been reviewed by a subscriber, and in response causing the voice message system to delete the message. Therefore, the Baxter patent also does not correct the deficiencies in the Qua et al. reference.

Further, it should also be noted that the Qua et al. patent refers to a "voice messaging system," but does not retrieve messages from the system, or manipulate the system in any way beyond leaving a voice message. Therefore, since the secondary references above relate to the processing of voice mail systems and messages, there would be no reason to think of combining their teachings with the Qua et al. patent. Their teachings would have no relevance to the audio note taking of the Qua et al. patent, nor is there any suggestion in the Qua et al. patent that such functionalities would be helpful in any way. Therefore, it would not be appropriate to combine the secondary references with the Qua et al. patent for 35 U.S.C. 103 purposes.

III. The Pending Claims Are Patentable

As discussed above, the principal reference used to reject each of the pending claims is the Qua et al. patent. The Qua et al. patent does not teach accessing a voice message system, retrieving, over a public telephone network, a voice message from the system, and generating a digital audio file from the retrieved message. Also, the Qua et al. patent does not teach receiving an e-mail indicating that a forwarded voice message has been reviewed by a subscriber, and in response causing the voice message system to delete the message. The secondary references applied by the Examiner do not make up for these deficiencies. Finally, there is nothing in any of the references to suggest combining the secondary references with the Qua et al. patent.

Applicant will now use bold highlight to point out the features of the individual claims which render them patentable over the applied references, and discuss the effects of the amendments on the claims in response to the Examiner's concerns.

1. Claims 1-13 Are Patentable

Claim 1 and claims 2-5, 7, and 9-13 which depend therefrom are patentable because claim 1, as currently amended, recites:

> A method of operating a communications device, the method comprising:
> accessing a voice message system;
> retrieving, over a public telephone network, a voice message from the voice message system;
> generating **from the retrieved voice message** a digital audio file representing said message; and
> sending, using at least one Internet Protocol (IP) packet, the digital audio file to a service subscriber.

In response to Examiner's concerns that claim 1 did not attach the retrieval of the voice message with the generation of the digital audio file, claim 1 has been amended to clarify that the digital audio file has been generated **from the retrieved voice message**. This amendment should alleviate Examiner's concerns, and should place claim 1 and dependent claims 2-5, 7, and 9-13 in condition for allowance.

Claims 2 and 3 have been amended to address the Examiner's concerns regarding antecedent bases. These amendments should alleviate Examiner's concerns.

Claim 6 stands allowed.

Claim 8 has been amended to address Examiner's concerns regarding the cooperative relation of the structural elements of the claim. It is respectfully submitted that the amendment to claim 8 should address those concerns.

Therefore, it is respectfully submitted that Claims 1-5 and 7-13 are allowable, and the rejection of those claims should be withdrawn.

2. **Claims 14-17 Are Patentable**

Claim 14 and claims 15-16 which depend therefrom are patentable because claim 14, as currently amended, recites:

> A method of controlling a voice message system, comprising **using a communication device to:**
>
> receive an E-mail message indicating that a voice message retrieved from said voice message system and forwarded to a service subscriber was reviewed;
>
> in response to receiving said E-mail message, access said voice message system; and
>
> control said voice message system to delete said retrieved voice message.

Claim 17 is patentable because claim 17, as currently amended, recites:

> A method of controlling a voice message system, comprising:
> receiving **at a communication device** an E-mail message indicating that a voice message retrieved from said voice message system and forwarded to a service subscriber was reviewed;
> operating a subscriber computer system to automatically generate said E-mail message when a user of the subscriber computer system accesses an E-mail message which includes said retrieved message as an attached audio file;
> in response to receiving said automatically generated E-mail message, **said communication device** accessing said voice message system by placing a telephone call to said voice message system over a telephone network; and
> **said communication device** sending a control signal to said voice message system over said telephone network causing said retrieved voice message to be deleted from said voice message system.

The Examiner's concern that claims 14-17 did not state that the "deletion is automatic and performed by the system itself" has been addressed by the highlighted amendments to independent claims 14 and 17.

Therefore, it is respectfully submitted that Claims 14-17 are allowable, and the rejection of those claims should be withdrawn.

3. **Claim 24 Is Patentable**

Claim 24 is patentable because claim 24, as amended, recites:

> A communication device, comprising:
> means for accessing a voice message system;
> means for retrieving a voice message from the voice message system over a public telephone network;
> means for generating **from the retrieved voice message** an E-mail message including the retrieved voice message as an attached audio file; and
> means for sending the E-mail message to a service subscriber.

As discussed in reference to Claim 1 above, this amendment should alleviate the Examiner's concerns regarding the connection between the generated retrieved

voice mail message and the E-mail message. Therefore, it is respectfully submitted that the Examiner withdraw the rejection of this claim 24.

4. Claim 25 Is Patentable

Claim 25 stands allowed.

5. Claims 29-35 Are Patentable

Claim 29 and claims 30-35 which depend therefrom are patentable because claim 29, as amended, recites:

> A method of operating a communications device coupled to a plurality of voice messaging systems, which are physically distinct units from said communications device, and to a computer system corresponding to a user of the communications device, the method comprising the steps of **causing the device to**:
>
> access the plurality of voice message systems corresponding to the user;
>
> retrieve voice messages from at least some of the plurality of voice message systems; and
>
> forward the retrieved voice messages to said computer system using at least one IP packet per message.

As has been argued above, claim 29 has been amended to more particularly point out the relationship between the steps taken and the device which implements the steps. This amendment should address Examiner's concerns regarding this claim 29.

Therefore, it is respectfully submitted that the Examiner withdraw the rejection of claims 29-35.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully submits that the pending claims are in condition for allowance. Accordingly, Applicant requests that the Examiner pass this application to issue.

If there are any outstanding issues which need to be resolved to place the application in condition for allowance the Examiner is invited to contact Applicant's undersigned representative by phone to discuss and hopefully resolve said issues. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136 is hereby made, the fee for which should be charged to Patent Office deposit account number 07-2347.

Respectfully submitted,

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